

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated September 28, 2006 (hereinafter Office Action) have been considered. Claims 1-62 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Claims 1-3, 5-8, 11-13, 16-23, 25-30, 32-38, 42, 44-46, 49-51, 52-53, 55 and 58-61 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,527,345 to *Infinger* (hereinafter "*Infinger*").

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Therefore, all claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102. The Applicant respectfully submits that *Infinger* does not teach each and every element of independent claims 1, 8, 23, 38, 42, 49 and 58, and therefore fails to anticipate these claims.

The Applicant's independent claims 1, 8, 23, 38, 42, 49 and 58 recite some variation of transitioning operation of the device from the monitoring mode, in which the energy delivery circuitry is disabled, to the energy delivery mode, in which the energy delivery circuitry is enabled.

The *Infinger* reference includes the following passage, which was cited by the Examiner on Page 4 of the Office Action, "[a]fter applying the cardioverting electrical energy to the atria, the microprocessor 62, through the enable/disable stage 64, enables the pacer output 84 and escape interval timer 86 over control line 89. This begins the post-cardioversion demand pacing of the heart. Pacing of the heart is enabled for a finite amount of time until the occurrence of a predetermined event." (Col. 7, Lines 40-45). The Examiner then goes on to state that "[t]he examiner considers this to be the controller transitioning operation of the device from the monitoring mode, in which the energy

delivery circuitry is disabled, to the energy delivery mode, in which the energy delivery circuitry is enabled.” (Office Action, Page 4).

The Applicant respectfully disagrees with the Examiner’s conclusion based on the quoted *Infinger* passage. For example, *Infinger* “enables the pacer output” “[a]fter applying the cardioverting electrical energy.” (Col. 7, Lines 40-42). As such, the energy delivery circuitry of *Infinger* device must have been enabled at all stages described, because *Infinger* discloses delivering electrical therapy at all stages described. The *Infinger* reference fails to describe a monitoring mode in which the energy delivery circuitry is disabled.

The Applicant’s independent claims 1, 8, 23, 38, 42, 49 and 58 recite some variation of transitioning operation of the device from the monitoring mode, in which the energy delivery circuitry is disabled, to the energy delivery mode, in which the energy delivery circuitry is enabled, which the *Infinger* reference clearly does not teach. As such, the *Infinger* reference fails to teach each and every element and limitation of independent claims 1, 8, 23, 38, 42, 49 and 58 and any anticipation of these claims by *Infinger* is unsustainable.

The Examiner further states that “since the device would have to be properly connected to the lead in order to sense cardiac activity, the system inherently transitions at least in part in response to coupling the cardiac lead to the lead interface.” (Office Action, Page 4). The Applicant respectfully disagrees with the above conclusion, particularly in light of the Applicant’s claims. For example, the Applicant’s independent claim 1 recites the controller transitioning operation of the device from the monitoring mode, in which the energy delivery circuitry is disabled, to the energy delivery mode, in which the energy delivery circuitry is enabled, at least in part in response to coupling the cardiac lead to the lead interface. *Infinger* does not teach, nor is it inherent, that coupling the cardiac lead to the lead interface at least in part transitions operation of the device from a monitoring mode, in which the energy delivery circuitry is disabled, to an energy delivery mode. The Applicant respectfully submits that if the Examiner considers maintaining the above

inherency contention notwithstanding the Applicant's rebuttal, the Examiner is compelled to produce the requisite supporting extrinsic evidence for this inherency contention.

Dependent claims 2, 3, 5-7, 11-13, 16-22, 25-30, 32-37, 44-46, 50, 51, 52, 53, 55 and 59-61, which are dependent from independent claims 1, 8, 23, 42, 49 and 58, respectively, were also rejected under 35 U.S.C. §102(b) as being unpatentable over *Infinger*. While the Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claims 1, 8, 23, 42, 49 and 58. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited reference. Therefore, dependent claims 2, 3, 5-7, 11-13, 16-22, 25-30, 32-37, 44-46, 50, 51, 52-53, 55 and 59-61 are also not anticipated by *Infinger*.

For at least these reasons, the Applicant respectfully submits that the rejection of claims 1-3, 5-8, 11-13, 16-23, 25-30, 32-38, 42, 44-46, 49-51, 52-53, 55 and 58-61 as being anticipated by *Infinger* is not sustainable.

Claims 4, 14, 15, 31, 39-41, 43, 48 and 62 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Infinger* in view of U.S. Patent No. 6,205,357 to *Ideker et al.* (hereinafter "*Ideker*"). Claims 9, 10, 24, 47, 54, 56 and 57 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Infinger*.

Three criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142.

Each of claims 4, 9-10, 14, 15, 24, 31, 39-41, 43, 47, 48, 54, 56, 57, and 62 depend from one of independent claims 1, 8, 23, 38, 42, 49, and 58, respectively. Independent claims 1, 8, 23, 38, 42, 49, and 58 are not obvious for at least the reason that the cited references fail to teach or suggest each and every limitation recited in each claim.

Furthermore, while the Applicant does not acquiesce with the particular rejections to these dependent claims, it is believed that these rejections are now moot in view of the remarks made in connection with independent claims 1, 8, 23, 38, 42, 49, and 58. These dependent claims include all of the limitations of the base claim and any intervening claims, and recite additional features which further distinguish these claims from the cited references.

Moreover, if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent claims 4, 9-10, 14, 15, 24, 31, 39-41, 43, 47, 48, 54, 56, 57, and 62 are not made obvious by *Infinger*, even in combination with *Ideker*.

As such, the Applicant respectfully requests withdrawal of the §103(a) rejection of claims 4, 9-10, 14, 15, 24, 31, 39-41, 43, 47, 48, 54, 56, 57, and 62 and notification that these claims are in condition for allowance.

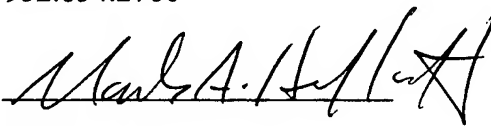
It is to be understood that the Applicant does not acquiesce to the Examiner's characterization of the asserted art or the Applicant's claimed subject matter, nor of the Examiner's application of the asserted art or combinations thereof to the Applicant's claimed subject matter. Moreover, the Applicant does not acquiesce to any explicit or implicit statements or conclusions by the Examiner concerning what would have been obvious to one of ordinary skill in the art, an obvious matter of design choice, inherent, and to what one of ordinary skill in the art would have expected the Applicant's invention to perform equally well as. Moreover, the Applicant specifically disputes that the Applicant has not disclosed advantages, uses for particular purposes, or problems solved by the various aspects of the Applicant's claimed invention, as contended by the Examiner in the Office Action. The Applicant respectfully submits that a detailed discussion of each of the Examiner's rejections beyond that provided above is not necessary, in view of the clear absence of teaching and suggestion of various features recited in the Applicant's pending claims. The Applicant, however, reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections.

Authorization is given to charge Deposit Account No. 50-3581 (GUID.048US01) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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Date: December 21, 2006

By: 

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